

REMARKS/ARGUMENTS

The Office has required an election of one of the following species.

Species I: Claims 4-9 and 17-25 (17, 22-25), representative Fig. 3, an electronic device having a graphite located between a die or an electronic part and a heat spreader.

Species II: Claims 10 and 14-16, representative Fig. 4, an electronic device having a condensable fluid.

Species III: Claims 11 and 12, representative Fig. 5 and 6, an electronic device having a lubricating member buried in one face of a heat spreader.

Applicants elect, with traverse, Species II (claims 10 and 14-16, representative Fig. 4), for examination purposes only. Claims 4-12, 14-17 and 22-25, as they read on the elected species, as subject to examination. Applicants note that Claims 18-21 were canceled in the Preliminary Amendment filed on February 27, 2004.

The Examiner characterized the claims of the invention as drawn to patentably distinct species, Species I-III, as noted on page 2 of the present Office Action. Thus, the Examiner required an election of species. Applicants respectfully traverse the Election of Species Requirement for the following reasons.

Applicants submit that the Office has not provided any reasons or examples to support the conclusion of patentable distinctness with respect to the elected species, but rather has merely stated the conclusion. Applicants note that for restriction to be proper, there must be a patentable difference between the species as claimed (see MPEP § 808.01(a)).

Applicants make no statement regarding the patentable distinctness of the species, but note that, for the election in this case, the Examiner generally concluded, on page 2 of the present Office Action, that the claims of the invention are directed to patentably distinct species, as shown above. However, the Examiner did not provide any reasons or examples to

support this statement, and thus, has not supported the requirement for this election. The burden is on the Office to provide reasons or examples to conclude that the inventions are patentably distinct, and not on the Applicants to establish that they are not (see MPEP § 803).

Therefore, the Office has not supported its conclusion of the above election of species, and has not shown that it would be a serious burden to search and examine the pending claims together. Applicants' election of species is for examination purposes only.

Applicants also respectfully submit that if the invention is so narrowed, as to cover only one of the elected species, as noted above, Applicants cannot adequately claim the invention, without filing numerous patent applications. This is an undue burden on the Applicants.

Finally, with respect to the elected species, Applicants respectfully submit that should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, for at least the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary, in order to sustain the Election of Species Requirement in the present application. Applicants respectfully request the withdrawal of the Election of Species Requirement.

Applicants respectfully submit that the present application is now in condition for examination on the merits, and request early notice of such action.

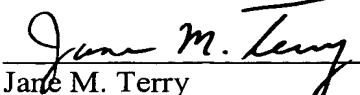
Respectfully submitted,

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